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Attorney Docket No: DN A01588
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JUL 08 2004

In re application of: Chen et al. : **Confirmation No.:** 7008

Serial No.: 10/715,087 : **Group Art Unit:** 1714

Filed: Nov. 17, 2003 : **Examiner:** K. Wyrozebski

OFFICIAL

For: SURFACTANT-CONTAINING INSULATION BINDER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO JUNE 24, 2004 OFFICE ACTION

I. Remarks

Applicants thank the Examiner for the courtesy of the telephone interview on July 7, 2004 with the undersigned. We discussed the fact that the Examiner inadvertently overlooked Hummerich U.S. Patent No. 6,071,994 in her Office Action. It is art more relevant than that applied by the Examiner in her Office Action. As explained in detail in Applicants' Information Disclosure Statement filed in March, Hummerich appears to anticipate claims 1, 2, 4, 5-9, 13, 14, and 17-20, and renders the remaining claims obvious. In that IDS, we presented a claim chart as Exhibit B and elaborated in more detail on page 4 how Hummerich anticipated the elements of claim 17 (mis-identified as claim 18). In her brief review of Hummerich and the IDS during the interview, the Examiner appeared to appreciate this relevance of Hummerich.

The Examiner indicated that in light of Hummerich, she would be issuing a new, non-final office action in both this case and in Applicants' parent U.S. Application Serial No. 09/871,467 applying Hummerich to the claims pending in both cases.

During the interview, the Examiner asked that we address the art rejections in the June 24, 2004 Office Action in this response. With the exception of the Section 102(f) rejection, we take no major exception to the art rejections in that Office Action at the present time. However, to the extent that Owens Corning, the owner of record of Applicants' parent U.S. Application Serial No. 09/871,467 takes exception to those rejections and one or more of those rejections are withdrawn, we reserve the right to reconsider our position as to those art rejections.

The only exceptions that we might take to the art rejections is that the Examiner has not availed herself of the procedure set forth in 37 C.F.R. §1.105 and requested Owens Corning to confirm that:

- (1) the use of mineral oil dust suppression agents has been practiced by Owens Corning for many years and is common prior art in the industry;
- (2) the process steps of claim 17-19 (without the binder composition of claim 1) have been practiced commercially for many years by Owens Corning. This is relevant to the applicability of Reck, for Reck teaches the use of surfactant-containing insulation binders in conventional fiberglass manufacturing processes generally.

Owens Corning commercial manufacturing practices are prior art, but Owens Corning has yet to disclose them to the patent office.

As to mineral oil dust suppressants, Applicants also take exception and direct the Examiner's attention to the 1988 International Programme on Chemical Safety – another item of prior art cited by Applicants and overlooked by the Examiner -- where it states "**MMMF [Man-made mineral fibers] usually contain a binder and mineral oil as a dust suppression agent.**" This also is relevant to the applicability of Reck which teaches the use of surfactant-containing binders in conventional fiberglass products of which mineral oil dust suppression is an invariable ingredient for health reasons (you don't want fiberglass dust to become airborne for obvious reasons).

As to the Section 102(f) rejection, we believe it is incorrect in light of the Declaration of Richard Dobrowolski where he states that he is a co-inventor of certain of the subject matters set forth in the pending claims. As discussed in the interview, we filed this Application because we believe Owens Corning neglected to name Mr.

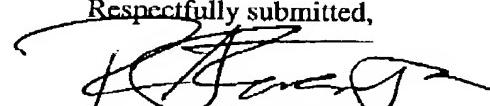
Dombrowski, a Rohm and Haas employee, as a co-inventor. As we explained in our Petition Under 37 C.F.R. §§ 1.47(a) & 1.181, we filed this case without the signatures of the Owens Corning inventors because they refused to sign. Also as explained in the interview, we filed this case to preserve Rohm and Haas' interest in any patentable subject matter that might remain in this case, so that the Patent Office, in the event of any allowance, might declare an interference that would decide the inventorship questions that Rohm and Haas has raised with Owens Corning.

II. Conclusion

In light of Hummerich and the International Programme (in combination with Reck and/or Hummerich), Applicants request that a new, non-final action be issued applying those references to the claims in both this Application and its parent.

The Section 102(f) rejection should be withdrawn.

Respectfully submitted,



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